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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAE K. BURNS, PATRICK F. SACK,
and VIKRAM REDDY PESATI

Appeal 2009-008742
Application 10/006,543
Technology Center 2100

Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III, and
JAY P. LUCAS, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge*
BLANKENSHIP.

Opinion Dissenting-In-Part filed by *Administrative Patent Judge* Lucas.
BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-40, which are all the claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellants' "invention relates to providing security of data in a database using access controls based on labels associated with a user and with data items in a database." Spec. ¶ [0001].

Representative Claim

6. A method for managing access to data in a database based on a database policy set of one or more label-based security policies, the method comprising the steps of:

registering, with a database management system, one or more packages of routines, wherein each package of said one or more package implements a security model that supports a model set of one or more policies of the database policy set and said each package includes an access mediation routine;

associating a first policy of a first model set in a first package with a first table within the database system; and

invoking the access mediation routine in the first package for determining whether to allow operation on data in the first table based on the first policy.

Examiner's Rejections

Claims 1-5 and 21-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ayi (US 2002/0143735 A1) and Hart (US 5,787,428).

Claims 6-20 and 26-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayman (US 5,859,966) and Ayi.

ANALYSIS

I. Appellants' Rule 131 Effort (Claims 1-5, 21-25)

Published Application US 2002/0143735 A1 (Ayi) is applied in rejections by the Examiner against all the claims. Ayi has a U.S. filing date of 30 August 2001 and was published 3 October 2002. Ayi also purports to be a continuation-in-part of an application filed 30 March 2001. Because Ayi was filed 30 August 2001, Ayi is prior art vis- à-vis Appellants under 35 U.S.C. § 102(e)(1), unless shown not to be prior, and also prior art under § 103(a).

In an effort to overcome the rejection of claims 1-5 and 21-25, Appellants presented a declaration signed by all the inventors. According to Appellants, the Declaration (with attached exhibits), filed 15 May 2006, establish that Appellants antedate Ayi under 37 C.F.R. § 1.131.

37 C.F.R. § 1.131 provides in pertinent part:

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

Appellants submit that the declaration demonstrates that Ayi is antedated because Appellants reduced the invention to practice prior to the effective filing date of Ayi, which according to the declaration is 30 March 2001.

A party seeking to antedate a reference based on reduction to practice must present evidence of the actual reduction to practice of the invention prior to the effective date of the reference. 37 C.F.R. § 1.131(b). An inventor cannot rely on uncorroborated testimony to establish a prior invention date. *Id.* It has long been the case that an inventor's allegations of earlier invention alone are insufficient -- an alleged date of invention must be corroborated. *Medichem S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1170 (Fed. Cir. 2006); *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371 (Fed. Cir. 1998). “[E]vidence is assigned probative value and collectively weighed to determine whether reduction to practice has been achieved.” *Medichem*, 437 F.3d at 1170. “Sufficiency of corroboration is determined by using a ‘rule of reason’ analysis, under which all pertinent evidence is examined when determining the credibility of an inventor’s testimony.” *Id.*

In re NTP, Inc., 654 F.3d 1279, 1291 (Fed. Cir. 2011).¹

The Appeal Brief does not explain how the Declaration shows reduction to practice but alleges that it does so and, apparently, invites us to read it and draw our own conclusions.²

According to the Declaration, Appellants “participated on a team that developed the implementation of claims 1-5 and 21-25 that is incorporated into an OracleTM database server product. After the design phase of the development, successful tests were run to show implementation worked according to claims 1-5 and 21-25.” Dec. ¶ 4. The tests “were completed

¹ We reject the notion in the briefs that the USPTO is required to accept Rule 131 affidavits at face value, without investigation, to the extent that it conflicts with the law of our reviewing court.

² *Cf.* 37 C.F.R. § 41.37(c)(1)(vii) (“Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown.”).

before the effective filing date of Ayi and were carried out in this country.”

Id. As corroboration, Appellants attach Exhibits A through D, which according to the Declaration shows that a script to test “the implementation” was successfully run at a date prior to 30 March 2001.

Exhibits A through C are alleged to be “true and correct” printouts. Dec. ¶¶ 5-7. Paragraph 8 of the Declaration submits that “Exhibit D is a true and correct printout” of a “test script log file,” while paragraph 9 of the Declaration submits that “Exhibit D has been annotated with bolded and bracketed comments that illustrate how Exhibit D supports the claim language of Claims 1-5 and 21-25.”

We find only one “Exhibit D” in the Evidence Appendix, which appears to be “annotated with bolded and bracketed comments.” It is not clear how an “annotated” printout might constitute “[o]riginal exhibits of drawings or records, or photocopies thereof . . .” 37 C.F.R. § 1.131(b).

In any event, the Declaration states that “Exhibit D has been annotated,” but does identify the person or persons who “annotated.” Nor does the Declaration state that Appellants have reviewed and agree with all the annotations. It is thus not clear that the “annotations” qualify as statements that Appellants testify are true or believed to be true, subject to penalty of “Section 101 [sic; 1001], Title 18,” as recited in the closing paragraph of the Declaration.³

³ See 37 C.F.R. § 1.68 (“[A] declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon.”).

Some of the unnumbered pages of Exhibit D do contain annotations that refer to claims by number, and appear to offer a synopsis of what portions of the test script log file do or show. However, consistent with the Examiner's findings, we do not see any explanation in the Declaration or attached Exhibits as to how an "implementation" consistent with the actual requirements of claims 1-5 and 21-25 worked prior to the critical date, as alleged. At best, Exhibit D with the annotations might be understood to show evidence of reduction to practice of *something*. However, neither the Declaration nor the "annotations" explain how the evidence demonstrates completion of the invention(s) of claims 1-5 and 21-25. Neither the Declaration nor the "annotations" even *address* the specific limitations of the invention(s) that Appellants allege was reduced to practice before the effective date of the reference.

We cannot say that completion of the claimed invention(s) could not be established by a satisfactory declaration that contained only the instant Exhibits as corroborating evidence. However, Ayi is -- *prima facie* -- a prior art reference. The burden to establish prior completion of the invention is Appellants', not the Examiner's or the Board's. *See In re Borkowski*, 505 F.2d 713, 718 (CCPA 1974) ("It was appellants' burden to explain the content of these notebook pages as proof of acts amounting to reduction to practice. That was not done."). In view of the shifted burden, presenting evidence in the hope that the Examiner will complete the record and show prior completion of the invention is analogous to an Examiner alleging in the first instance, with nothing more, that "claims 1-5 and 21-25 are unpatentable over Ayi under 35 U.S.C. §§ 102 and/or 103. Read the reference."

We agree with Appellants (Reply Br. 4-5) to the extent that a “strict correlation” between exhibits and each claim limitation is not necessarily required.⁴ However, the Declaration appears to allege (but does not show) that a “strict correlation” exists between the proffered evidence and the limitations of each of claims 1-5 and 21-25. “We conceived and reduced to practice *an implementation of claims 1-5 and 21-25* before the effective filing date of Ayi.” Dec. ¶ 3 (emphasis added). Moreover, Appellants in the Appeal Brief quote a sentence from MPEP § 715.07, but emphasize the wrong portion. “**An accompanying exhibit need not support all claimed limitations**, provided that any missing limitation is supported by the declaration itself.” App. Br. 10 (emphasis in original). We emphasize that an accompanying exhibit need not support all claimed limitations, **provided that any missing limitation is supported by the declaration itself**.

Appellants submit that the Declaration contains “facts” showing a completion of the invention commensurate with the extent of the invention as claimed (App. Br. 8), but as support refer to allegations of fact and legal conclusions in the Declaration (*see id.*) that address none of the claim limitations.

In view of the foregoing, we conclude that the showing of facts, in character and weight, is insufficient to establish reduction to practice by a preponderance of the evidence prior to the effective date of Ayi. *Cf.* 37

⁴ Appellants add the odd argument (*id.*) that many inventions such as “database-related inventions” are so “low level in nature,” “transparent,” or not sufficiently described that cited references might not be antedated when actual claim limitations are at issue. That may be true. However, 37 C.F.R. § 1.131 is not available for such inventions.

C.F.R. § 1.131(b). On this record, Ayi constitutes prior art. Since Appellants rely on the Declaration as a complete response to the rejection of claims 1-5 and 21-25, we sustain the § 103(a) rejection over Ayi and Hart.

II. Rejections of Claims 6-20, 26-40

Based on Appellants' arguments in the Appeal Brief, we find that Appellants have provided arguments for separate patentability (*see* 37 C.F.R. § 41.37(c)(1)(vii)) with respect to representative base claim 6 and representative dependent claims 8, 10, 11, 13, and 20, each of which depend directly or indirectly from claim 6.

We adopt the Examiner's findings and conclusions set forth in the Final Rejection and the Answer. We sustain the Examiner's rejections. We add the following remarks for emphasis.

Claim 6

Appellants highlight the claim 6 requirement of "registering" one or more packages of routines as distinguishing over the references. However, we agree with the Examiner that the Specification teaches that "registering" of routines was routine in the art. As quoted from the Specification (§ [0057]) at pages 11 and 12 of the Appeal Brief, the "registering" might require no more than typing the name of the file containing the package in a graphical user interface. Moreover, in view of this record, "registering" of packages requires no more than making the packages available for use, regardless of *when* the packages are made available. Further, neither the claims nor the written description require that "registration" is limited to software packages that can be customized by the user, as suggested at page

13 of the Appeal Brief. Moreover, even if the capability of customization were required, Hayman teaches (as pointed out by the Examiner) that the security software can be modified or customized. *See* Hayman col. 8, l. 67 - col. 9, l. 14; col. 10, ll. 1-4. We thus are not persuaded of error in the Examiner's finding that the installation of security software (as taught by Hayman) requires that the software be "registered" with the system within the meaning of claim 6.

Appellants' arguments with respect to Hayman not teaching a security policy package associated with a "table" within a database system are also unavailing. The Examiner's rejection of claim 6 acknowledges that Hayman teaches the security policy is applied to an object, and not specifically a "first table within the database system." The rejection of claim 6 relies on Ayi as teaching applying labels to tables in a database.

Appellants' arguments also appear to not appreciate the breadth of the claimed "first package" of routines, which does not preclude the various parts of the Hayman security system. For example, Appellants argue there is no teaching or suggestion that the "Session Monitor" of Hayman is associated with a table or other data objects within a database system. Reply Br. 6. However, the "Session Monitor" (Hayman col. 8, l. 54 - col. 9, l. 14) is but part of the security system. As set forth in the Examiner's rejection (Ans. 10), invoking the access mediation routine in the first package to determine whether to allow operation on data based on the first policy is taught by material in Hayman that includes description of the "Reference Monitor" (col. 9, l. 55 - col. 10, l. 4). The Reference Monitor invokes policy modules from the Information Security Policy Table, described as "subject-to-object" access policies, to mediate all requests to an object by a subject.

We do not find any satisfactory response from Appellants that address the operations of the Reference Monitor. We are not persuaded that the teachings of Hayman and Ayi fail to demonstrate the obviousness of “invoking the access mediation routine in the first package for determining whether to allow operation on data in the first table based on the first policy” as claimed.

Claim 8

Appellants allege that Hayman does not teach “how” each package is formed. App. Br. 15. We note, however, that the claim does not specify or limit “how” a package is formed. Appellants also allege that Hayman fails to teach the recited “administrative routines,” which are for “defining” the first policy. *Id.*

We agree with the Examiner that Hayman teaches the “administrative routines” to the extent claimed. Hayman teaches that the Information Security Policy Table database can be configured when the system software is first installed, to meet the specific security policy of the specific computer system. Hayman col 9, l. 66 - col. 10, l. 3. The database configuration for defining a policy for the model set is effected by one or more “administrative routines” consistent with claim 8, as Hayman does not teach that the tables configure themselves.

Claim 11

Appellants suggest that the language of claim 11 with respect to the “plurality of parameters” has not been addressed in the Answer. Reply Br.

8. We refer Appellants to pages 11 and 12 of the Answer, and are persuaded of no error in the Examiner's findings.

Claim 20

Claim 20 recites storing the set of allowed labels in a "session cache" for a communication session between the database management system and the user. Appellants argue that Hayman and Ayi lack any mention of the term "cache" or anything equivalent. App. Br. 17.

According to the Specification, a "session cache" is merely a "data structure holding data related to the communications session." Spec. ¶ [0054]. Ayi teaches that rules for establishing a policy may be contained in a "dataset" suitable for storage in a database system. The references would have, at the least, suggested storing the set of allowed labels in a data structure for a communication session between the database management system and the user, as claimed, for the purpose of transferring the data between the database management system and the user.

DECISION

The rejection of claims 1-5 and 21-25 under 35 U.S.C. § 103(a) as being unpatentable over Ayi and Hart is affirmed.

The rejection of claims 6-20 and 26-40 under 35 U.S.C. § 103(a) as being unpatentable over Hayman (US 5,859,966) and Ayi

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

LUCAS, *Administrative Patent Judge*, dissenting-in-part.

In relevant part, 37 C.F.R. § 1.131 (a) and (b) read:

§ 1.131 Affidavit or declaration of prior invention.

<>

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim... may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. . . .

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference... Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

Notwithstanding the misgivings of my colleagues, after having carefully reviewed the Declaration and Exhibits, I find that all of the limitations of each of the claims 1 to 5 and 21 to 25 are demonstrated by a preponderance of the evidence to have been reduced to practice prior to the effective date of the Ayi reference. The notations placed in the Exhibit D re-submission of August 27, 2008 in response to an objection of the Examiner, sufficiently direct this adjudicator to the demonstrations in the Test Script supporting the actual reduction to practice of each claim. Those notations are affirmed by the Declaration of the Inventors.

My colleagues have raised objections to the form of the Declaration and Exhibits. Certainly any submission can be improved. However, taken as a whole, I find the Declaration, supported by the Exhibits, in light of the

acknowledgement of the obligation to make truthful statements, satisfies the requirements of the regulation above.

I thus conclude for the purposes of the rejection of claims 1 to 5 and 21 to 25 that the Ayi reference is not part of the prior art, and the Examiner has erred in making this rejection.

I concur with my colleagues with respect to the rejection of claims 6 to 20 and 26 to 40 under 35 U.S.C. § 103(a).